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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,132	02/09/2001	Lawrence M. Sherman	07473-033	1690
30623	7590	01/26/2006	EXAMINER	
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C. ONE FINANCIAL CENTER BOSTON, MA 02111			KOPPIKAR, VIVEK D	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/781,132

Applicant(s)

SHERMAN, LAWRENCE M.

Examiner

Vivek D. Koppikar

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-5, 10, 11, 13-15, 17, 18, 20, 21, 26, 27, 29-32, 37, 38, 40-44, 46, 48-55, 60, 61, 63 and 64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/20/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims pending in the application are 2-5,10,11,13-15,17,18,20,21,26,27,29-32,37,38,40-44,46,48-55,60,61,63 and 64.

**DETAILED ACTION**

***Status of the Application***

1. Claims 2-5, 10-11, 13-15, 17-18, 20-21, 26-27, 29-32, 37-38, 40-44, 46, 48-55, 60-61 and 63-64 have been examined in this application. The Information Disclosure Statement (IDS) statement filed on February 20, 2002 have been acknowledged. This action is in response to the May 24, 2005 election of the above mentioned claims.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 50 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. An insurance policy is not included within the statutorily set forth types of patentable subject matter (above).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2-5, 10-11, 13-15, 17-18, 20-21, 26-27, 29-32, 37-38, 40-44, 46, 48-55, 60-61 and 63-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 5,845,256 to Pescitelli in view of US Patent Number 6,584,446 to Buchanan.

(A) As per claims 2 and 4, Pescitelli teaches a method for providing an insurance policy for one person and another person (Pescitelli: Abstract) comprising:

identifying the persons as insured parties under the insurance policy

(Pescitelli: Col. 13, Ln. 6-15);

obtaining information regarding the persons (Pescitelli: Col. 13, Ln. 6-15);

entering information regarding the persons into a data processing apparatus and

determining in the data processing apparatus eligibility of the persons by comparing information received regarding the persons with one or more standards stored in the data processing apparatus (Pescitelli: Col. 3, Ln. 40-50);

entering information related to a benefit amount into the data processing apparatus

(Pescitelli: Col. 8, Ln. 27-49);

entering information related to at least one beneficiary of the insurance policy into the data processing apparatus (Pescitelli: Col. 11, Ln. 21-30);

entering information related to a first (or second) physical condition for the persons into the data processing apparatus (Pescitelli: Col. 8, Ln. 1-26);

entering information related to a benefit qualification time frame into the data processing apparatus (Pescitelli: Col. 7, Ln. 56-62 and Col. 8, Ln. 1-26); and

generating the insurance policy using the data processing apparatus from the information relating to the eligible persons, the benefit amount, the at least one beneficiary, the first physical condition and the benefit qualification time frame (Pescitelli: Col. 4, Ln. 64-67)

Pescitelli does not teach that the insurance policy creates an obligation of an insurer to pay the benefit amount upon the one person assuming the first physical condition: (i) at a time the another person assumes the first physical condition, or (ii) after the another person assumes the first physical condition and within the benefit qualification time frame, however, this feature is well known in the art as evidenced by Buchanan (Col. 3, Ln. 36-48). At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the method of Pescitelli with the aforementioned feature from Buchanan with the motivation of providing an

enhanced policy for the long term care expectations for beneficiaries of an insured, as recited in Buchanan (Col. 1, Ln. 65-Col. 2, Ln. 6).

(B) As per claims 3 and 5, the combined method of Pescitelli and Buchanan does not teach that the first physical condition comprises death and that the second condition comprises permanent incapacity (Pescitelli: Col. 3, Ln. 51-56), however, the examiner takes Official Notice that it is well known in the insurance industry to ask a series of health-related questions to potential insureds wherein these questions are related to determining how likely that insured is to developing a condition which causes death or permanent incapacity. At the time of the invention, it would have been obvious for one of ordinary skill in the art to have modified the combined method of Pescitelli in view of Buchanan with this aforementioned feature with the motivation of obtaining more accurate data enabling the insurance company to better project the amount of benefits they would have to pay to their insureds.

(C) As per claim 10, in the combined method of Pescitelli in view of Buchanan the at least one beneficiary is financially dependent (relative) upon at least one of the persons (Pescitelli: Figure 4G and Col. 11, Ln. 21-30).

(D) As per claim 11, in the combined method of Pescitelli in view of Buchanan the step of obtaining information regarding the persons includes obtaining responses to one or more questions (Pescitelli: Col. 2, Ln. 62-Col. 3, Ln. 14).

(E) As per claim 13, in the combined method of Pescitelli in view of Buchanan the insurance policy includes a term to designate a period of time the insurance policy is effective (Pescitelli: Col. 7, Ln. 56-62 and Col. 8, Ln. 1-26).

(F) As per claims 14-15, 17-18, 20-21, 26-27, 29-32, 37-38, 40-44, 46, 48-55, 60-61 and 63-

64, the claims repeat features previously addressed in the rejection of claims 2-5, 10-11 and 13 and are rejected on the same basis.

*Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivek Koppikar, whose telephone number is (571) 272-5109. The examiner can normally be reached from Monday to Friday between 8 AM and 4:30 PM.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Another resource that is available to applicants is the Patent Application Information Retrieval (PAIR). Information regarding the status of an application can be obtained from the (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAX. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please feel free to contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,



Vivek Koppikar

1/18/2006



C. LUKE GILLIGAN  
PATENT EXAMINER